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Paper No. 25

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OFFICE OF PETITIONS

Schwegman, Lundberg, Woessner & Kluth, PA
PO Box 2938
Minneapolis, MN 55402

In re Application of Huang et al. :
Application No. 09/513,010 :
Filing Date: February 25, 2000 :
Attorney Docket No. H16-26156-1623 :

Decision on Petition

This is a decision on the petition under 37 CFR 1.137(a), filed July 5, 2005, to revive the above-identified application.

The petition is **DISMISSED**.

Facts:

The Board of Patent Appeals and Interferences mailed a decision on January 14, 2005.

The decision was sent to the address of record:

HONEYWELL INTERNATIONAL INC.
101 COLUMBIA ROAD
PO BOX 2245
MORRISTOWN, NJ 07962-2245

The decision was not sent to the address listed on the petition.

The petition appears to be asserting the abandonment was unavoidable because a decision was never received at the address listed on the petition.

Analysis:

The petition cannot be granted for several reasons.

The petition fails to prove that the Board decision was never received at the address of record.

A terminal disclaimer has not been filed. A terminal disclaimer and fee are required in applications filed on or after June 8, 1995, but before May 29, 2000, if the application became abandoned (1) *during appeal*, (2) during interference, or (3) while under a secrecy order. The

reason being that utility and plant patents issuing on applications filed on or after June 8, 1995 but before May 29, 2000 are eligible for the patent term extension under former 35 U.S.C. 154(b). *Note* MPEP, 703(c)(I)(G).

An application abandoned as a result of failure to timely seek court review of a BPAI decision can be revived under 37 CFR 1.137(b), but the PTO cannot even consider the petition under 35 U.S.C. 133 and 37 CFR 1.137(a) (regardless of the cause of the delay).¹

35 U.S.C. 133 states that:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, ... as fixed by the Commissioner, the application shall be regarded as abandoned ... , unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

As stated above, 35 U.S.C. § 133 gives the Commissioner the authority to revive an application abandoned due to unavoidable delay *if* the application was abandoned for failure to prosecute after an Office action for which notice has been given. However, the instant application did not become abandoned for failure to prosecute the application within the meaning of 35 U.S.C. 133. Instead, proceedings were terminated due to applicant's failure to file an appeal or commence a civil action. Therefore, the Commissioner does not have the authority to revive the application under 37 CFR 1.137(a).

If petitioner desires to continue prosecution of the application before the Patent and Trademark Office, he may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b) since the authority to revive for unintentional delay is not derived from 35 U.S.C. 133. A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply (already submitted), the required petition fee (\$1,500 for a large entity), and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. A copy of a blank petition form is enclosed for petitioner's convenience.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a request to change the address of record should be filed. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. Extensions of time

¹ See Mobil Oil Corporation v. Dann, 198 USPQ 347 (D.D.C. 1978); and In re Bryan, 2 USPQ2d 1215 (Comm'r. Pat. 1986; see also Morganroth v. Quigg, 885 F.2d 843, 12 USPQ2d 1125 (Fed. Cir. 1989) (the Commissioner's authority to revive abandoned applications under 35 USC §§ 41(a)(7) or 133 does not extend to a case where the abandonment consisted of a failure to appeal a final district court judgement).

under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

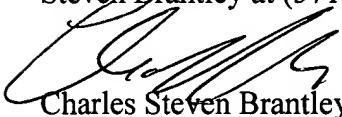
By facsimile: (571) 273-8300
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

If a request for reconsideration is filed, and a decision on the new petition is not received within three months, petitioner may wish to call the number below to check on the status of the renewed petition.

If a request for reconsideration is not filed, the file will be forwarded to Files Repository.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

Attached: PTO/SB/64